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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,300	10/23/2003	Xinzhan Peng	020031-002710US	1465

20350 7590 03/14/2005

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EXAMINER

WARD, PAUL V

ART UNIT PAPER NUMBER

1623

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/693,300	Applicant(s) PENG ET AL	
	Examiner PAUL V. WARD	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the Restriction requirement in the reply filed on January 28, 2005 is acknowledged. The traversal is on the ground(s) that Groups I and II should be joined and searched on their merits. Applicant's argument is found persuasive because both Groups are classified in the same class and can be search without serious burden.

Additionally, Applicant is entitled to Group III rejoined under M.P.E.P. § 821.04, if the claims of Groups I and II are ultimately found allowable, and Applicant reserved the right to file a divisional application to the non-elected subject matter.

An action on the merits of Groups I and II (claims 1-24) is contained herein.

Claim Rejections - 35 USC § 102

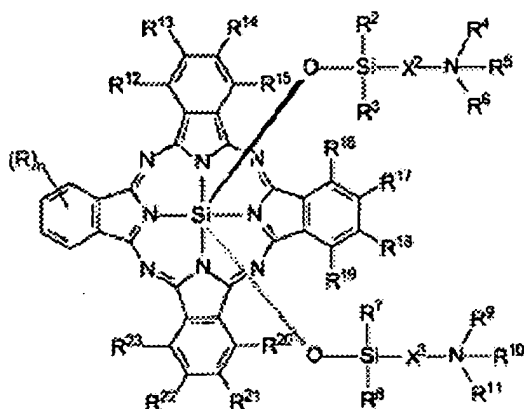
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kenney et al. (U.S. Patent 5,484,778).

Applicants claim phthalocyanine dye compounds of general formula I:



wherein all the variables are defined in the claims.

Kenney teaches phthalocyanine compounds and corresponding conjugates having the exact formula I as Applicant. (See Abstract and Formula I, col. 6). The compound in the U.S. Patent has the same structure and falls within the range of the presently claim phthalocyanine compounds. (See col. 6, line 5 to col. 7, line 19, and col. 9, line 1 to col. 10, line 25). Since Kenney teaches the exact compounds, Applicant claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

2. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kenney et al. (U.S. Patent 5,166,197).

Kenney teaches phthalocyanine compounds and corresponding conjugates having the exact formula I as Applicant. (See Abstract and Formula I, col. 6). The compound in the U.S. Patent has the same structure and falls within the range of the presently claim phthalocyanine compounds. (See col. 6, lines 13-52, and col. 8, lines 5-48). Since

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Kenney teaches the exact compounds, Applicant claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

3. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Rywkin et al. (Transfusion).

Rywkin teaches phthalocyanine compounds and corresponding conjugates having the exact formula I as Applicant. (See Abstract and Study Design and Methods, page 414). The compound in the reference has the same structure and falls within the range of the presently claim phthalocyanine compounds. (See pages 414-420). Since teaches the exact compounds, Applicant claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

4. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Rywkin et al. (Photochemistry and Photobiology).

Rywkin teaches phthalocyanine compounds and corresponding conjugates having the exact formula I as Applicant. (See Abstract). The compound in the reference has the same structure and falls within the range of the presently claim phthalocyanine compounds. (See page 166, Figure 1). Since teaches the exact compounds, Applicant claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney et al. (U.S. Patent 5,484,778).

Kenney teaches a generic group of phthalocyanine derivatives, which embraces Applicants' claimed compounds. (See Formula 1, col. 6, and definitions for M, Y G, X R' and R"). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed

compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

6. Claims 1-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Rywkin et al. (Photochemistry and Photobiology).

Rywkin teaches a generic group of phthalocyanine derivatives, which embraces Applicants' claimed compounds. (See Formula 1, Abstract, and pages 165-170). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

7. Claims 1-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney et al. (U.S. Patent 5,166,197).

Kenney teaches a generic group of phthalocyanine derivatives, which embraces Applicants' claimed compounds. (See Formula 1, col. 6, col. 8 and definitions for M). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

Conclusion

Claims 1-24 are pending. Claims 1-24 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V. WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Richard Raymond", is written over a horizontal line.

Richard Raymond
Primary Examiner
Technology Center 1600